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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MONSTER CABLE PRODUCTS, INC.,

Opposer,

v.

JOEL BARRY SHAMITOFF,

Applicant.

Opposition No. 91152044

**APPLICANT'S REPLY IN SUPPORT
OF MOTION FOR SUMMARY
JUDGMENT**



05-06-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

I. INTRODUCTION

Applicant Joel Shamitoff has met his burden of showing that there is no evidence to support Monster Cable Products, Inc.'s opposition to registration of the mark MONSTERSNAPS for use in connection with plush toys. In particular, Shamitoff has established that (1) his products and Monster Cable's products are so different that confusion is unlikely as a matter of law; (2) Monster Cable cannot meet the difficult standard for establishing fame in the field of toys for purposes of its dilution claim; and (3) Monster Cable cannot establish actual dilution as required by the Supreme Court's recent opinion in Moseley v. V Secret Catalogue, Inc., 123 S. Ct. 1115 (2003).

The evidence Monster Cable offers in response to Shamitoff's showing is not relevant to the grounds upon which Shamitoff's motion is brought. Indeed, the evidence serves only to

confirm that the undisputed facts upon which Shamitoff relies are true: namely, that Monster Cable uses its MONSTER marks on computer cables and related products, and that its worldwide brand recognition extends only to products in that limited field. Monster Cable does offer a vague reference to future "plans" to distribute plush toys. But Monster Cable cannot occupy the field and preclude registration of trademarks containing the word MONSTER for use on toys merely by stating that it might someday want to expand the use of its marks into a new product line. Indeed, as noted in Shamitoff's opening brief, International Class 28 already contains multiple registered trademarks containing the word MONSTER – the owners of which, including Shamitoff, will have priority over any proposed use by Monster Cable on toys.

There are no genuine issues of material fact as to either of Monster Cable's claims. This Board should conclude as a matter of law that confusion is unlikely and that Monster Cable cannot meet the requirements of federal dilution law, and should enter summary judgment on behalf of applicant.

II. ARGUMENT

A. Monster Cable Has Failed to Raise a Genuine Issue of Material Fact Concerning its Likelihood of Confusion Claim.

1. Monster Cable's Burden on Summary Judgment.

Monster Cable has failed completely to meet its burden of coming forward with *specific evidence* to establish a genuine issue of material fact. Indeed, Monster Cable's opposition seems premised on a misunderstanding of the law of summary judgment. The Federal Rules of Civil Procedure provide:

When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth *specific facts* showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party.

Fed. R. Civ. P. 56(e) (emphasis added). The moving party has the "initial burden of demonstrating the absence of any genuine issue of material fact." E.g., Mattel, Inc. v. Nurik, Opp. No. 103,659, 1997 TTAB LEXIS 148 at *8 n.6 (TTAB 1997). As the Supreme Court has explained, "[T]he burden on the moving party may be discharged by 'showing' -- that is, pointing out to the district court -- that there is an absence of evidence to support the nonmoving party's case." Celotex Corp. v. Catrett, 477 U.S. 317, 325 (1986). Once the moving party has established its right to judgment, the opposing party "*must* proffer countering evidence sufficient to create a genuine factual dispute." Sweats Fashions, Inc. v. Pannill Knitting Co., Inc., 833 F.2d 1560, 1562 (Fed. Cir. 1987) (emphasis added); see also Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 626-27 (Fed. Cir. 1984) (party opposing summary judgment bears the burden of setting out specific evidence that creates a genuine issue of material fact). As discussed more fully below, Monster Cable has offered no such evidence.

2. Shamitoff Does Not Bear the Burden of Proving the Absence of Genuine Issues of Material Fact as to All of the DuPont Factors.

Monster Cable argues that Shamitoff's motion for summary judgment should be denied because Shamitoff "fails to demonstrate the absence of a genuine issue of material fact" with regard to each of the likelihood of confusion factors set forth In re E.I. DuPont deNemours & Co., 476 F.2d 1357 (CCPA 1973). Opp. at 4. Again, Monster Cable misapplies the law of summary judgment. Shamitoff does not bear the burden of proving that there is no genuine issue of material fact as to *any* of the likelihood of confusion factors. Rather, as noted above, Shamitoff's burden is to point out to this Board "that there is an absence of evidence to support [Monster Cable's] case." Celotex, 477 U.S. at 325; see also Sweats Fashions, 833 F.2d at 1563 ("the burden is not on the movant to produce evidence showing the absence of a genuine issue of material fact") (citing Celotex).

Shamitoff's burden has clearly been met. In his motion for summary judgment, Shamitoff established that his intended products are so different from Monster Cable's products that as a matter of law, consumer confusion is impossible. That the intended products are toys,

where use of the word MONSTER is ubiquitous, also demands a conclusion that confusion is unlikely. In the face of this showing, Monster Cable has failed to come forward with specific evidence demonstrating a genuine issue of material fact as to likelihood of confusion. In other, similar cases, this Board has not hesitated to grant summary judgment on behalf of the applicant where "it is clear that the goods to which the parties apply their marks are so different in nature that confusion is unlikely to result from the contemporaneous use of the marks in connection with such goods." Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 U.S.P.Q. (BNA) 151 (TTAB 1983), aff'd, 739 F.2d 624, 626-27 (Fed. Cir. 1984). Indeed, the Board has granted summary judgment on this basis even where it *expressly noted* the existence of genuine issues of fact as to other DuPont factors, stating: "Although these are genuine issues of fact, we do not find them to be material facts. Even if the Board were to resolve these issues in favor of opposer, the Board would still find that there would be no likelihood of confusion, given the difference in the goods involved here." Id.; see also Mattel, supra (granting summary judgment on the basis of a single DuPont factor).

The holding of Pure Gold applies equally here. Shamitoff has established that the parties' products are so different that confusion is not likely to result from his use of MONSTERSNAPS in connection with plush toys. Monster Cable has failed to raise a genuine issue of material fact as to likelihood of confusion, an issue as to which it bears the burden of proof in opposing Shamitoff's application. Accordingly, summary judgment is warranted. Pure Gold, supra.¹

¹ A similar claim is pending before the Board in Monster Cable Products, Inc. v. Brunswick Bowling & Billiards Corp., Opp. No. 91124683 (TTAB Feb. 13, 2003), cited by Monster Cable. In Brunswick, the applicant similarly moved for summary judgment on Monster Cable's claim of likelihood of confusion, arguing that there is no likelihood of confusion as a matter of law between Monster Cable's use of its marks and Brunswick's proposed use of MONSTER on bowling balls. This Board has deferred a ruling on Brunswick's motion, giving Monster Cable additional time to conduct "*very limited*" discovery to the extent necessary to complete briefing on this issue. Order at 4-5 & n.6 (emphasis added). Here, of course, Monster Cable has already completed discovery – but, significantly, has not cited any of it in its opposition to Shamitoff's motion.

3. Monster Cable Offers No Evidence to Support its Claim that the Doctrine of Natural Expansion Applies.

Effectively conceding the absence of any likelihood of confusion between the products it currently produces and those contemplated by Shamitoff's application, Monster Cable then argues that it is going to expand its product line into the field of plush toys. There are at least two critical problems with this argument. First, Monster Cable has offered no specific evidence concerning this purported expansion, other than the flat statements of its own counsel and a Senior Product Manager that Monster Cable has "formulated plans" to produce and market plush toys. (Payne Dec. ¶ 2; Everett Dec. ¶ 8.) It is worth noting that there is no evidence that Monster Cable has filed an ITU application for this "planned" use of its MONSTER trademark on plush toys.²

Second, Monster Cable has made no factual showing whatsoever that plush toys lie within the zone of natural expansion of its line of computer cable products. This Board has explained the natural expansion doctrine as follows:

Under the doctrine of natural expansion, the first user of a mark in connection with particular goods or services possesses superior rights in the mark . . . as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark. . . . The application of the doctrine is strictly limited to those cases where the expansion, whether actual or potential, is "natural," that is, where the goods or services of the subsequent user, on the one hand, and the goods and services as to which the first user has prior use, on the other, are of such nature that purchasers would generally expect them to emanate from the same source.

Mason Engineering and Designing Corp. v. Mateson Chemical Corp., 225 U.S.P.Q. (BNA) 956 (TTAB 1985). The Board went on to outline a number of factors that are relevant to the determination whether an expansion is or is not "natural," including whether the second area of business is a "distinct departure" from the first, the nature and purpose of the goods in each area,

² If it does so, of course, there are a number of other trademark owners – including applicant – who will have priority. See Selvan Dec. in Support of Motion for Summary Judgment at ¶ 3 & Ex. A.

whether the channels of trade and classes of customers are the same in each area, and whether other companies have expanded from the first area to the second. See id.

Monster Cable has not even attempted to offer any evidence concerning any of these factors. Although Mr. Everett asserts in conclusory fashion that plush toys are “within the zone of Monster Cable’s natural expansion,” there is no evidence whatsoever in the record to support his statement – for example, showing the nature and purpose of computer cables vs. plush toys, comparing the channels of trade and classes of customers, or indicating that other companies have also expanded from the computer cable field into the field of plush toys. In the absence of any such evidence, Monster Cable has not met its burden of showing that a genuine issue of material fact exists. Summary judgment is therefore warranted. See Mattel, 1997 TTAB LEXIS 148 at *8 n.6 (opposer’s unsupported arguments and assertions of its marketing executive did not “evidence a genuine issue of material fact for trial”).

B. Monster Cable Has Failed to Raise a Genuine Issue of Material Fact Concerning its Dilution Claim.

1. Monster Cable Has Offered No Specific Evidence Concerning the Fame of its Marks in the Field of Toys.

Monster Cable argues strenuously that its marks are famous, or (apparently alternatively) that the question whether its marks are famous is itself a genuine issue of material fact. Monster Cable misapprehends Shamitoff’s argument. Shamitoff does not attempt to argue that Monster Cable’s marks are not famous; rather, for purposes of this motion, he assumes the fame of Monster Cable’s marks *within their field*. But in order for Monster Cable to preclude the registration of a mark containing the word MONSTER for use on plush toys, it must be able to prove that its mark “has become the principal meaning of the word” in connection with plush toys. See Toro Co. v. ToroHead, Inc., 61 U.S.P.Q.2d (BNA) 1164 (TTAB 2001). Given the complete absence of any use of Monster Cable’s marks on plush toys, Monster Cable cannot meet its burden of proof on this element of its dilution claim.

Contrary to Monster Cable's assumption, this Board's order in Brunswick does not dispose of the issues here. Indeed, there are obvious and critical differences between the facts of Brunswick and this case:

- There was apparently no evidence in the record in Brunswick concerning third party use of the MONSTER mark on bowling balls. Here, as set forth in Shamitoff's opening brief, there is evidence of extensive third party registration *and* use of marks containing the word MONSTER on plush toys.
- Brunswick sought to use the identical mark – MONSTER – on bowling balls. Here, Shamitoff seeks to use a mark – MONSTERSNAPS – that offers a different commercial impression.
- Brunswick apparently contended that Monster Cable's marks are not famous. See Order at 5. Here, Shamitoff admits *arguendo* that Monster Cable's marks are famous in the field of computer cables. However, Shamitoff argues that as a matter of law -- given that Monster Cable does not use any of its marks on plush toys, and that many third parties do -- Monster Cable's marks cannot be famous as to such products. The Board's order in Brunswick does not bear on that issue.³

Once again, Monster Cable has failed to meet its burden of showing a genuine issue of material fact. Although it has presented evidence, largely anecdotal, about the fame of its brand, it has not presented any evidence whatsoever that consumers of plush toys associate any mark containing the word MONSTER with Monster Cable. Monster Cable states in conclusory fashion that "Even though Monster does not currently produce or distribute plush toys, its fame *does* reach into Applicant's trading area." Opp. at 17 (emphasis in original). But again, this statement is not supported by any evidence, much less specific evidence. See Pure Gold, 739

³ Also, the Board's order in Brunswick predated the United States Supreme Court's opinion in Moseley v. V Secret Catalogue, Inc., 123 S. Ct. 1115 (2003), and does not discuss the requirement of actual dilution which is set forth in that opinion. See discussion infra.

F.2d at 626 ("In countering a motion for summary judgment, more is required than mere assertions of counsel."). In the absence of any such evidence, summary judgment is warranted.

2. Monster Cable Cannot Establish Actual Dilution of its Marks.

As set forth in Shamitoff's memorandum in support of his motion for summary judgment, the United States Supreme Court has held that federal law "unambiguously requires a showing of actual dilution" in order to prevail on a dilution claim. Moseley v. V Secret Catalogue, Inc., 123 S. Ct. 1115 (2003). The language of the Supreme Court's opinion is itself unambiguous, and it requires that summary judgment be entered in Shamitoff's favor.

Monster Cable argues that the holding of Moseley frustrates the intent of Congress. Opp. at 20. That is an issue for Congress, not for this Board. Indeed, the same argument was made and rejected in Moseley. The Moseley Court, ruling unanimously, held that Congress's choice of the active verb "causes" when describing the prohibited activity made actual harm a required element of a statutory violation. Id. It is undisputed that such actual harm has not occurred here. It surely would make no sense for this Board to hold, in the absence of any explicit directive from Congress, that the Board has *broad*er jurisdiction over dilution claims than the federal courts. In short, under the holding of Moseley, Monster Cable cannot establish a required element of its dilution claim, and a grant of summary judgment is therefore warranted.

III. CONCLUSION

For the reasons discussed above and in Applicant's opening brief, Applicant requests that this Board enter summary judgment in his favor and against Monster Cable on its opposition.

Dated: May 6, 2003

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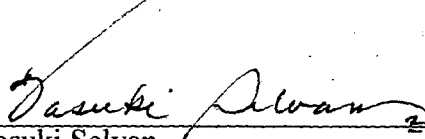
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT** was served by first class mail on:

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this 6th day of May, 2003.



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Re: In the Matter of Trademark Application Serial No. 76/278,209
Date of Publication: January 31, 2002
Applicant - Joel Barry Shamitoff
Opposer - Monster Cable Products, Inc.
Opposition No. - 91152044
APPLICANT'S REPLY IN SUPPORT OF MOTION FOR
SUMMARY JUDGEMENT

Dear Sir or Madam:

We enclose on behalf of our client, Joel Barry Shamitoff, an original and two copies of the APPLICANT'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGEMENT in the above-referenced matter.

Please stamp the enclosed self-addressed acknowledgment postcard "received" and return same to me. Postage has already been affixed to the postcard for your convenience.

Thank you for your assistance in this matter. If you should have any questions, please do not hesitate to contact me.

Very truly yours,

Vasuki Selvan
Trademark Specialist

Enclosures

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